UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,280	07/19/2006	Fabio Vignoli	US040044US2	8784

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EXAMINER
LIAO, JASON G

ART UNIT	PAPER NUMBER
2169	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/597,280	VIGNOLI ET AL.
	Examiner	Art Unit	
	JASON LIAO	2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>23 December 2008</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,3-9 and 11-20</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1, 3-9, 11-20</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>23 December 2008</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some *   c) ☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____.

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1, 3-9, 11-20 are pending in this action with claims 1, 11 amended, and claims 2,

10 are cancelled.

Drawings

2.   Replacement drawings submitted on 23 Dec 08 are accepted.

Response to Amendment

3.   All rejections and objections directed to claims 2, 10 are withdrawn.

4.   Amendments show that the claims are limited to systems specifically for the generation

playlists, and therefore the examiner withdraws the 35 U.S.C. 101 rejection under Bilski.

Response to Arguments

5.   **Applicant's arguments have been considered but are moot in view of the new**

ground(s) of rejection.

Regarding the idea behind the inventive concept, the examiner could not find direct support

predating the claimed priority date relating to iTunes 4.0 with that specific feature. However, the

iTunes playlist format clearly contemplates inclusion of items from multiple, non-local sources.

The Gonze Survey using an iTunes playlist example, demonstrates songs from disparate

locations (both gonze.com and epitomic.com). As of Nov 17, 2003, iTunes clearly had at least

the capability of multi-source playlists.

Claim Objections

6.   **Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.** Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 11 now depends upon claim 10, rather than itself. However, claim 10 is listed as cancelled on the claim sheet.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   **Claims 1, 3-9, 11-20 are rejected under 35 U.S.C. 103(a) as obvious over iTunes 4.0 hereinafter iTunes in view of A survey of playlist formats (http://gonze.com/playlists/playlist-format-survey.html) hereinafter Gonze.**

With respect to claim 1, iTunes discloses

a system for generating a playlist of a plurality of items, said system comprising:

A playlist generator (www.apple.com/itunes/smartplaylists.html),

a selector for selecting the items to form the playlist

(www.apple.com/itunes/theater/playlists.html, GUI interface including mouse):

a collection of items of a user (www.apple.com/itunes/smartplaylists.html,

"And with iTunes 4, you simply indicate your desired criteria — like all the rock songs you've

added to your library in the past month.")

one or more new-items from one or more other sources of items

(/www.apple.com/music/store/)

and a mixer that is configured to generate a playlist based on the selections made

by the selector from the plurality of items

(www.apple.com/itunes/smartplaylists.html, "The power to create playlists

by mixing music tracks from different albums and genres has always been

one of the cool features of iTunes.") and one or more new-items

(/www.apple.com/music/store/ top picture, "Download songs directly to

your music library"), the selector is configured to select the plurality of

items (www.apple.com/itunes/theater/playlists.html, mouse pointer) and

one or more new-items (www.apple.com/music/store/browse.html, "The

iTunes Music Store is so user-friendly and so easy to navigate that you can

drill down several layers deep with just a few mouse clicks, and search the

store's entire music inventory in seconds.") based on preferences of the

user (www.apple.com/itunes/smartplaylists.html, Constructs based on date

range, ratings, etc.), and

the collection of items of the user does not include the one or more new-

items(www.apple.com/music/store/browse.html,

"http://web.archive.org/web/20031002021025/www.apple.com/music/store/browse.html").

iTunes further discloses the ability to add items to a playlist from a collection(www.apple.com/itunes/smartplaylists.html), and importation of media from another source (www.apple.com/music/store/shop.html), but does not directly disclose:

wherein when generating the playlist [...] optionally made part of said collection of items.

Gonze discloses selects an item from a source other than the collection of items of the user, the said item can be placed in the playlist (http://gonze.com/playlists/playlist-format-survey.html#iTunes, iTunes playlist format supports locations from both local (gonze.com) and non-local (epitomic.com)). As these are world wide web links, they allow the user to download the material, and thus Gonze discloses when generating the playlist, [the content is] optionally made part of said collection of items (by downloading from the provided link).

iTunes is directed to playlists and Gonze describes properties of the iTunes playlist. It would have been obvious to one skilled in the art to combine the teachings of iTunes and Gonze in order to allow a broader possibility of songs to be indexed in the playlist.

With respect to claim, 3 iTunes discloses rendering the playlists (www.apple.com/itunes/theater/playlists.html, playlist is displayed at end)

With respect to claim 4, iTunes discloses including a purchase module (www.apple.com/music/store/shop.html) that is configured to facilitate a selective purchase

(www.apple.com/music/store/shop.html "When you're ready to buy a song, it gets even easier.

The iTunes Music Store is designed for instant gratification, letting you buy a song with just one

click.") of each of the one or more new-items (www.apple.com/music/store/shop.html "Unlike

the case with CDs, where you have to pay for the whole album to get the two or three songs you

really want, the iTunes Music Store lets you buy only the songs you really like and want to

own.").

With respect to claim 5, iTunes discloses the selector includes a memory (iTunes can run on the

Macintosh. Macintoshes are Personal Computers that include memory) that is configured to

store identifications of previously selected new-items, and the one or more new-items exclude

the previously selected new-items, based on the identifications

(www.apple.com/music/store/shop.html, Source pane has storage source labeled "Sarah

Brightman" www.apple.com/itunes/theater/playlists.html, generation can be based on artists. It

is implicit that generation of a new source by other well known artists would exclude Sarah

Brightman.).

With respect to claim 6, iTunes discloses a recommender module that is configured to create of

subset of source items from the one or more other sources of items, based on one or more general

preferences of the user (www.apple.com/itunes/theater/playlists.html, selection of preferences

narrows possible songs in generated playlist), wherein the selector selects the one or more new-

items from the subset of source items (www.apple.com/itunes/theater/browse.html, selector can

select items from a subset based on preferences).

With respect to claim 7, iTunes discloses the one or more other sources of items are accessible

via an Internet access (www.apple.com/music/store/shop.html, iTunes shop is accessible over the

internet)

With respect to claim 8, iTunes discloses determining a preferred proportion of new-items

relative to the plurality of items (www.apple.com/itunes/theater/playlists.html, user has an option

for "Live updating")

With respect to claim 9, iTunes discloses the selector is further configured to select the one or

more new-items based on a popularity of each new-item of the one or more new-items

(www.apple.com/itunes/theater/playlists.html, User has the option to select parameters based on

ranking such as number of stars).

With respect to claim 11, iTunes discloses memory that is configured to store ancillary

information associated with each new-item that is selectively added to the collection of items

(www.apple.com/itunes/theater/browse.html, new songs have information such as rating, author,

etc.), to facilitate subsequent selections (www.apple.com/itunes/theater/playlists.html,

information is used as selection criteria).

With respect to claim 12, iTunes discloses A method of generating a playlist

(www.apple.com/itunes/theater/playlists.html shows actions being performed) comprising:

Selecting the items (www.apple.com/itunes/theater/playlists.html, GUI interface including

mouse) from a collection of items of a user (www.apple.com/itunes/smartplaylists.html, added to

library) and/or one or more new-items from one or more sources of items

(www.apple.com/music/store), based on preferences of the user

(www.apple.com/itunes/smartplaylists.html, "And with iTunes 4, you simply indicate your

desired criteria — like all the rock songs you've added to your library in the past month."); and

Combining the selected plurality of items and the one or more new-items to provide therefrom

the playlist (www.apple.com/itunes/smartplaylists.html, "The power to create playlists by mixing

music tracks from different albums and genres has always been one of the cool features of

iTunes.")

Wherein the one or more new-items are exclusive of items in the collection of items of the user

(www.apple.com/music/store/browse.html,

"http://web.archive.org/web/20031002021025/www.apple.com/music/store/browse.html").

iTunes further discloses the ability to add items to a playlist after addition into a

collection, and importation of media from another source (e.g a CD), but does not directly

disclose:

wherein when generating the playlist [...] optionally made part of said collection of items.

Gonze discloses selects an item from a source other than the collection of items of the user, the said item can be placed in the playlist (http://gonze.com/playlists/playlist-format-survey.html#iTunes, iTunes playlist format supports locations from both local (gonze.com) and non-local (epitomic.com)). As these are world wide web links, they allow the user to download the material, and thus Gonze discloses when generating the playlist, [the content is] optionally made part of said collection of items (by downloading from the provided link).

iTunes is directed to playlists and Gonze describes properties of the iTunes playlist. It would have been obvious to one skilled in the art to combine the teachings of iTunes and Gonze in order to allow a broader possibility of songs to be indexed in the playlist.

With respect to claim 13, iTunes discloses rendering the playlists (www.apple.com/itunes/theater/playlists.html, playlist is displayed at end).

With respect to claim 14, iTunes discloses including a purchase module (www.apple.com/music/store/shop.html) that is configured to facilitate a selective purchase (www.apple.com/music/store/shop.html "When you're ready to buy a song, it gets even easier. The iTunes Music Store is designed for instant gratification, letting you buy a song with just one click.") of each of the one or more new-items (www.apple.com/music/store/shop.html "Unlike the case with CDs, where you have to pay for the whole album to get the two or three songs you really want, the iTunes Music Store lets you buy only the songs you really like and want to own.").

With respect to claim 15, iTunes discloses the selector includes a memory (iTunes can run on the Macintosh. Macintoshes are Personal Computers that include memory) that is configured to store identifications of previously selected new-items, and the one or more new-items exclude the previously selected new-items, based on the identifications (www.apple.com/music/store/shop.html, Source pane has storage source labeled "Sarah Brightman" www.apple.com/itunes/theater/playlists.html, generation can be based on artists. It is implicit that generation of a new source by other well known artists would exclude Sarah Brightman.).

With respect to claim 16, iTunes discloses a recommender module that is configured to create of subset of source items from the one or more other sources of items, based on one or more general preferences of the user (www.apple.com/itunes/theater/playlists.html, selection of preferences narrows possible songs in generated playlist), wherein the selector selects the one or more new-items from the subset of source items (www.apple.com/itunes/theater/browse.html, selector can select items from a subset based on preferences).

With respect to claim 17, iTunes discloses the elements and limitations of claim 8, and further discloses combining the plurality of items and the one or more new-items to provide the playlist is based on the preferred proportion (www.apple.com/itunes/theater/playlists.html, user has an option for "Live updating").

With respect to claim 18, iTunes discloses the selector is further configured to select the one or

more new-items based on a popularity of each new-item of the one or more new-items

(www.apple.com/itunes/theater/playlists.html, User has the option to select parameters based on

ranking such as number of stars).

With respect to claims 19, iTunes discloses the system is further configured to facilitate

selectively adding each new-item of the one or more new-items to the collection of items

(www.apple.com/itunes/theater/browse.html).

With respect to claim 20, iTunes discloses memory that is configured to store ancillary

information associated with each new-item that is selectively added to the collection of items

(www.apple.com/itunes/theater/browse.html, new songs have information such as rating, author,

etc.), to facilitate subsequent selections (www.apple.com/itunes/theater/playlists.html,

information is used as selection criteria).

Conclusion

9.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JASON LIAO whose telephone number is (571)270-3775. The

examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Pierre Vital can be reached on 571-272-4215. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. T./
Examiner, Art Unit 2167

17 Mar 09

/Jason Liao/
Examiner, Art Unit 2169

/Pierre M. Vital/
Supervisory Patent Examiner, Art Unit 2169